



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/990,234	11/21/2001	Torbjorn Boson Lundqvist	21532-301	2349

25204 7590 06/14/2002

OPPENHEIMER WOLFF & DONNELLY LLP
840 NEWPORT CENTER DRIVE
SUITE 700
NEWPORT BEACH, CA 92660

EXAMINER

ALLEN, ANDRE J

ART UNIT	PAPER NUMBER
----------	--------------

2855

DATE MAILED: 06/14/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/990,234

Applicant(s)

LUNDQVIST, TORBJORN BOSON

Examiner

Andre J. Allen

Art Unit

2855

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- ☐ Interview Summary (PTO-413) Paper No(s). ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1,10,17,18 and 24 provisionally rejected under the judicially created doctrine of double patenting over claim 1 of copending Application No. 09716295. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: The co-pending application teaches all the basic features of the

claimed invention for example: A housing, transmitter, a counter pressure chamber, signaling means, a housing adapted to mate with a tire valve, providing a tire monitoring device and calibrating and a transparent lens, however it does not disclose emitting a signal when a pressure in a first chamber is greater than a pressure located in a second pressure. However, since claims 1-8 of the co-pending application teaches at least a counter pressure chamber and calibrating pressure to monitor a tire it would appear to be well within the experimental skills of one in the ordinary skill in the art to provide another pressure chamber to further improve on monitoring pressure in a tire by utilizing both chambers as claimed in the following application.

Therefore it would have been clearly obvious of one ordinary skilled in the art at the time the invention was made to provide whatever specific characteristics of the said device of claims 1-8 of the co-pending application 09716295 if desired for the purpose of optimizing the characteristics of the pressure monitoring device

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Art Unit: 2855

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the word "means" is preceded by the word(s) "signaling" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph.

See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).

With respect to claim 1 it is not clear how a "signaling means" is structurally related to the structural elements as claimed.

With respect to claim 1 it is not clear how the housing, main housing, and lower housing are connected with respect to a "main housing" and "lens"

With respect to claim 10 and the recitation "said lower housing is coupled to said lower housing body", it is not clear how a lower housing can be connected to itself.

Art Unit: 2855

With respect to claim 10, the recitations “said counter pressure chambers” and “said main pressure chamber” are not properly recited, that is the invention was never understood to have a counter-pressure chamber and main pressure chamber.

With respect to claims 17 and 24 the recitation “said adapted” is improper, the phrase adapted can not establish physical structure between the said housing and said valve.

With respect to claims 20 and 21, this claim is intended to be a method, therefore it must provide a step to establish a method.

With respect to claim 21 the recitation “may be” is futuristic can the signal be selected or not.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,5,6,7,8,9,18-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Ballyns. Ballyns reads on the claimed invention as follows: a tire monitoring apparatus comprising;

- A housing 12 having a first pressure chamber 38, a second pressure chamber 40, and a flexible membrane 36, wherein said first and second pressure chambers are separated by a flexible membrane {abstract}; and
a signaling means 64 located within said housing, wherein said signaling means emits a warning signal when a pressure within the first pressure chamber is greater than a pressure within the second pressure chamber.
{abstract}
- said housing further includes at least one battery {col. 6 lines 60-64}.
- said flexible membrane is a conductive substance {col. 6 lines 21-22}. (claims 6 and 7)
- said signaling means is coupled to a printed circuit board {fig. 2}.
- said signaling means is selected from the group consisting of a light emitting diode (LED), a speaker, a radio frequency (RF) transmitter, and an infrared (IR) transmitter. {col. 7 lines 1-25} (claims 9 and 21)
- Attaching said tire pressure monitoring device to a tire valve {col. 10 lines 20-30}; calibrating said tire pressure monitoring device;

Art Unit: 2855

- Monitoring a pressure differential between said tire pressure monitoring device and an air pressure of said tire; and
- Emitting a warning signal when said pressure differential exceeds a predetermined pressure differential. {col. 8 lines 24-65}
- Allowing air from said tire to enter a counter-pressure chamber of said tire pressure monitoring device and sealing {col. 5 lines 54-60} said counter-pressure chamber.
- Said warning signal may be a signal selected from the group consisting of a light, a sound, a radio frequency (RF) wave, and an infrared (IR) light.

Claim Rejections - 35 USC § 103

- 4 The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-4, 10-17, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ballyns in view of Chi.

Ballyns teaches the basic features of the claimed invention however, Ballyns does not disclose;

Art Unit: 2855

- A transparent lens, a screw cap that couples the lens to a housing and a conductive gasket.
- Removing the device to ensure the device is properly working, adding air to a tire and then reattaching the monitoring device.

Chi discloses a tire monitoring apparatus comprising;

- A transparent lens {abstract} that is threaded 22 to be coupled to a housing.
- A conductive gasket 7

With respect to removing the device to ensure the device is properly working, adding air to a tire and then reattaching the monitoring device, it would have been obvious to one having ordinary skill in the art at the time the invention was made to disclose these features since they are in the field of monitoring tire pressure, and it has been held that mere duplication of the essential working parts of a device only involves routine skill in the art

Since the references of Ballyns and Chi are both from the same field of endeavors, the purpose disclosed by Chi would have been recognized by the pertinent art of Ballyns.

It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the tire monitoring apparatus taught by Ballyns with a transparent lens and a gasket as taught

Art Unit: 2855

by Chi for the purpose of creating a tire monitoring apparatus that operates at optimum performance.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andre J. Allen whose telephone number is 703-3081989. The examiner can normally be reached on mon-fri 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ben Fuller can be reached on 703-308-0079. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-3432 for regular communications and 703-308-3432 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.

A.J.A
June 6, 2002


Benjamin R. Fuller
Supervisory Patent Examiner
Technology Center 2800

Application/Control Number: 09/990,234

Page 10

Art Unit: 2855